

Applicants: Cornelia J. Forster et al.
Application No.: 10/632,340

REMARKS

Claim Amendments

Applicants have amended claim 1 to delete the term "CH" from the definition of W. Applicants have also deleted the proviso from claim 1 which is, therefore, no longer necessary. Support for these amendments may be found throughout the specification as originally filed, e.g., page 12, paragraph [0045].

Applicants have canceled claims 5 and 6.

Applicants have amended claim 12 to recite only compounds wherein W is nitrogen. Support for this amendment may be found throughout the specification as originally filed, e.g., pages 12-13.

Applicants have amended claim 13 to correct a spelling error.

Applicants have amended claim 14 to recite an amended list of diseases. Support for this amendment may be found throughout the specification as originally filed, e.g., pages 20-21, paragraph [0081].

Applicants have amended claim 15 to recite a specific list of biological samples. Support for this amendment may be found throughout the specification as originally filed, e.g., page 21, paragraph [0083]. Applicants have also deleted the phrase "a composition according to claim 13" from claim 15.

Applicants have added new claim 24. Support for this amendment may be found in the originally filed claims and throughout the specification.

None of these amendments adds new matter.

The Official Action

35 U.S.C. §112, First Paragraph

The Examiner has rejected claim 14 under 35 U.S.C. §112, first paragraph as lacking enablement. The Examiner contends that the specification, while being enabling for a method of treating leukemia, does not reasonably provide enablement for a method of treating any or all diseases or conditions. The Examiner further contends that the applicants have not provided any competent evidence that the instantly disclosed tests are highly predictive for all the uses recited in the claims.

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Applicants respectfully disagree with the Examiner's rejection, but have amended claim 14 to expedite prosecution. Amended claim 14 recites a composition additionally comprising an additional therapeutic agent selected from an antipsychotic agent, an agent for treating stroke, an antidepressant, or an agent for treating diabetes.

The Examiner has rejected claim 15 under 35 U.S.C. §112, first paragraph as lacking enablement. The Examiner contends that the specification, while being enabling for a method of inhibiting GKS-3 activity in a standard biological assay, does not reasonably provide enablement for a method of inhibiting GSK-3 activity in a biological sample generally. Applicants respectfully disagree. Nevertheless, to expedite prosecution, applicants have amended claim 15 to recite a biological sample "selected from cell cultures or extracts thereof, biopsied material obtained from a mammal or extracts thereof, blood, saliva, urine, feces, semen, and tears" as disclosed in the application as originally filed. Based on applicants' teachings (e.g., see page 32, Example 17), a skilled practitioner could practice the method of amended claim 15 without undue experimentation.

For all of the above reasons, applicants request that the Examiner withdraw these 112, first paragraph rejections.

The Obviousness-Type Double Patenting Rejection

The Examiner has rejected claims 1-15, 18, and 23 under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-15 of United States Patent 6,696,452 (hereafter "the '452 patent"). Applicants traverse.

Applicants have amended claim 1 to delete the term "CH" from the definition of W. Applicants have also canceled claims 5 (due to redundancy) and 6 (directed to compounds wherein W is CH), and have amended claim 12 to recite compounds wherein W is nitrogen (rather than CH).

Accordingly, applicants request that the Examiner withdraw these double patenting rejections.

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CONCLUSION

Applicants request that the Examiner enter the above amendments, consider the accompanying remarks, and allow the claims to pass to issue. If the Examiner believes that a telephone call would expedite prosecution, the Examiner is invited to contact the undersigned at any time.

Respectfully submitted,



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